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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,967	02/22/2000	Frank David Serena	11423-002001	2781

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EXAMINER
NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/507,967	Applicant(s) SERENA, FRANK DAVID	
	Examiner George C Neurauter	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 December 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *35-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *35-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *10* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 35-42 and 44-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka et al. [US Patent 6 366 298 B1] and in view of Landsman et al. [US Patent 6 314 451 B1].

Regarding claim 35, Haitsuka discloses a method of controlling content in a processing environment in which the content may be accessed, the method comprising: receiving input from a user; monitoring content in the processing environment to be accessed by the user; determining whether monitored content corresponds to a predetermined advertisement; if the monitored content corresponds to the predetermined advertisement, selecting a selected advertisement, based on the user input. [column 5, lines 44-58; column 6, lines 4-17; column 9, lines 27-52]

Haitsuka does not expressly disclose selecting a selected advertisement for incorporation into the content and causing the content to be accessed by the user with the selected advertisement incorporated therein, however, Landsman does disclose these limitations [column 5, line 46-column 6, line 8].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Haitsuka and Landsman because, at the time of the invention of Landsman, the teachings of Landsman were well known and used in the art. Therefore, one of ordinary skill would have known and used the idea of inserting advertisements into content as disclosed in Landsman with the teachings of Haitsuka of selecting advertisements for client viewing and arrived at the invention as disclosed in claim 35.

Claims 48, 49, and 51 are also rejected under 35 USC 103(a) since claims 48, 49, and 51 contain the same limitations as recited in claim 35.

Regarding claim 36, Haitsuka and Landsman disclose the method of claim 35.

Haitsuka discloses wherein the predetermined advertisement is one of a plurality of advertisements from which the: selected advertisement is selected. [column 5, lines 44-58, specifically lines 54-56]

Regarding claim 37, Haitsuka and Landsman disclose the method of claim 35.

Haitsuka discloses wherein the content to be accessed by the user is content to be viewed by the user. [column 4, line 57-column 5, line 12]

Regarding claims 38-42, Haitsuka and Landsman disclose the method of claim 35.

Haitsuka and Landsman do not expressly disclose wherein the content to be accessed by the user comprises text, video, sounds, images, or movies.

However, these differences are only found in the nonfunctional descriptive material and are not functional involved in the steps recited. The method described by Haitsuka and Landsman would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use content such as text, video, sounds, images, or movies because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Regarding claim 44, Haitsuka and Landsman disclose the method of claim 35.

Haitsuka discloses wherein the processing environment is a computer application program or a communication channel between an operating system residing at a users computer system and the computer application program. [column 3, line 60-column 5, line 22]

Regarding claim 45, Haitsuka and Landsman disclose the method of claim 35.

Haitsuka discloses wherein monitoring content comprises monitoring information related to the originator of content. [column 9, lines 27-52]

Regarding claim 46, Haitsuka and Landsman disclose the method of claim 35.

Haitsuka discloses wherein the step of receiving input from a user comprises receiving directly from the user information about content that the user wishes to control. [column 4, line 57-column 5, line 12; column 5, lines 44-58]

Regarding claim 47, Haitsuka and Landsman disclose the method of claim 35.

Haitsuka discloses wherein the step of receiving input from a user comprises observing information relating to the user and generating content preferences based on these observations. [column 6, lines 4-17]

4. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka et al. and Landsman et al. as applied to claim 35 above, and further in view of Murray [US Patent 6 061 659 A].

Regarding claim 43, Haitsuka and Landsman disclose the method of claim 35.

Haitsuka and Landsman do not disclose wherein the processing environment through which the content is accessed by the user comprises a television tuner for receiving television signals that carry the content, however, Murray does disclose this limitation [column 1, lines 38-44, specifically line 40]

It would have been obvious to one skilled in the art at the time the invention was made to use interactive television as described in Murray as the processing environment as described above regarding claim 35 in Haitsuka and Landsman because, at the time of the invention of Murray, interactive television as a processing environment was well known and used in the art. Therefore, one of ordinary skill would have known and used the interactive television processing environment with the method of controlling content as described in Haitsuka and Landsman and would have arrived at the invention as recited in claim 43.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5 901 287 A to Bull et al;

US Patent 6 434 745 B1 to Conley, Jr. et al;

US Patent 6 330 554 B1 to Altschuler et al;

US Patent 6 134 532 A to Lazarus et al;

WO 01/20481 A2 to Hosea et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C Neurauter whose telephone number is 703-305-4565. The examiner can normally be reached on Mon-Fri 9am-5:30pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

gcn
February 23, 2003

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100